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| 09/932,213      | 08/17/2001  | William Webb         | PALM.P0863          | 5012             |

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| EXAMINER |
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NGUYEN, JIMMY H

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| ART UNIT | PAPER NUMBER |
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2629

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06/25/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/932,213 | <b>Applicant(s)</b><br>WEBB ET AL. |  |
|                              | <b>Examiner</b><br>JIMMY H. NGUYEN   | <b>Art Unit</b><br>2629            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-21, 24-26 and 45-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-21, 24-26 and 45-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/24/2010 has been entered. Claims 19-21, 24-26 and 45-50 are currently pending in the application. An action follows below:

#### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claim(s):

There is no drawing to show the "claimed" mobile device of claim 19 and its dependent claims. Specifically, the features, "wherein an overall width of the mobile device is (i) maximized when the second segment is in the extended position, and (ii) minimized when the second segment is in the contracted position, wherein the overall width of the mobile device is reduced when the second segment is moved towards the contracted position from the extended position so that when the second segment is in the contracted position the second segment is overlaid and external to the first segment" and "a set of one or more input mechanisms provided on the second segment so as to be exposed when the second segment is in the extended position and when in the contracted position", presently recited in last 12 lines of **claim 19**.

There is no drawing to show the "claimed" mobile device of claim 45 and its dependent claims. Specifically, the features, "wherein an overall width of the mobile device is (i)

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maximized when the second segment is in the extended position, and (ii) minimized when the second segment is in the contracted position, and wherein the overall width of the mobile device is reduced when the second segment is moved towards the contracted position as compared to when the second segment is in the extended position; so that when the second segment is in the contracted position, the second segment is overlaid and external to the first segment” recited in lines 4-11 of **claim 45** and “wherein when the second segment is in the contracted position, the first segment and the second segment are at least partially overlaid, so that the display assembly is at least partially blocked”, presently recited in last 4 lines of **claim 45**;

“wherein the first segment overlays the second segment so that the display assembly covers at least a portion of one or more of the input mechanisms from the set of one or more input mechanisms” of **claim 49**.

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet”

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. (Twice Objected) The amendment filed 9/28/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: figures 18-19 are NOT accepted by the examiner. See the Office Action dated 12/23/2009.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 19-21, 24-26 and 45-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Re **claims 19 and 45**, these claims require a mobile device comprising the following features:

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(a) “a second segment including a set of one or more input mechanisms is overlaid and external to a first segment including a display assembly when the second segment is in the contracted position” AND

(b) “wherein **an overall width** is maximized when the second segment is in the extended position and minimized when the second segment is in the contracted position and wherein the overall width of the mobile device is reduced when the second segment is moved towards the contracted position from the extended position so that when the second segment is in the contracted position the second segment is overlaid and external to the first segment.”

The original disclosure, specifically Figs. 1-2 and the corresponding specification from pages 7-11, explicitly discloses a mobile device 100 comprising a second segment 120 **overlying ONLY a portion** of a first segment 110 including a display assembly 125 when the second segment is in the contracted position, while the claimed invention, in contrast, includes a (whole) second segment 120 **being overlaid** by a first segment 110.

Further, the original disclosure, specifically Fig. 11, discloses that when the second segment is in the contracted position, a portion of the first segment 110 disposed into the second segment 120, while the claimed invention includes “a (whole) second segment 120 **being external** to a first segment 110.

Further, the original disclosure, specifically the specification, page 21, last paragraph, discloses:

“While embodiments described above provide for housing segments to reduce a length of handheld computer 100, other embodiments may provide for a similar configuration to be used for a width of handheld computer 100, where lateral sides 105, 105 can be moved closer to or further away from each other by first segment 110 and second segment 120.”

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The above mentioned disclosure explicitly discloses that other embodiment(s) may provide for a similar configuration to be used for a variation in a width of a handheld computer. However, the above mentioned disclosure does not explicitly disclose the mobile device of these embodiment comprising at least the claimed feature, (a) “a second segment including a set of one or more input mechanisms is overlaid and external to a first segment including a display assembly when the second segment is in the contracted position.”

In other words, the original disclosure, specifically the above mentioned specification, at most discloses a mobile device capable of varying the width of the mobile device and does not disclose a mobile device comprising BOTH the above underlined features (a) and (b), as presently recited in these claims.

Additionally to claim 19, this claim contains the limitation, “a set of one or more input mechanisms provided on the second segment so as to be exposed when the second segment is in the extended position and when in the contracted position” in last 3 lines, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Additionally to claim 45, this claim contains the limitation, “wherein when the second segment is in the contracted position,..., so that **the display assembly is at least partially blocked**” in last 4 lines, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Accordingly, these claims contain the above underlined features, which were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Re **claims 20, 21 and 24-26**, since these claims depend upon claim 19, these claims are therefore rejected for the same reason set forth in claim 19 above.

Additionally to **claim 24**, this claim contains the limitation, “a midframe coupled to the first segment and the second segment”, which was not described in the original disclosure at the time the application was filed. As discussed above, the above mentioned original disclosure, specifically the specification, page 21, last paragraph, does not explicitly teach the handheld computer (or the claimed mobile device), which is capable of varying its width, including the “claimed” midframe.

Additionally to **claim 25**, this claim contains the limitations, “wherein the midframe .... the extended position” in lines 1-5, which were not described in the original disclosure at the time the application was filed. As discussed above, the above mentioned original disclosure, specifically the specification, page 21, last paragraph, does not explicitly teach the handheld computer (or the claimed mobile device), which is capable of varying its width, including the above underlined limitation of this claim.

Additionally to **claim 26**, this claim contains the limitations, “wherein the midframe ... the extended position” in lines 1-8, which were not described in the original disclosure at the time the application was filed. As discussed above, the above mentioned original disclosure,



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specifically the specification, page 21, last paragraph, does not explicitly teach the handheld computer (or the claimed mobile device), which is capable of varying its width, including the above underlined limitation of this claim.

Re **claims 46-50**, since these claims depend upon claim 45, these claims are therefore rejected for the same reason set forth in claim 45 above.

Additionally to **claim 47**, this claim contains the limitation, “wherein the multi-directional mechanism includes a set of one or more buttons”, which was not described in the original disclosure at the time the application was filed. As discussed above, the above mentioned disclosure, specifically the specification, page 21, last paragraph, does not explicitly teach the handheld computer (or the claimed mobile device), which is capable of varying its width, including the above underlined limitation of this claim.

Additionally to claim 48, this claim recites the limitation, “wherein **one or more** of the input mechanisms from the set of **one or more** input mechanisms...mechanical input mechanisms”, which includes “wherein **two, three, or four** of the input mechanisms from the set of **one** input mechanism”, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Further, examiner can’t understand how two or more input mechanisms are from a set of ONLY one input mechanism.

Additionally to claim 49, this claim recites the limitation, “... **one or more** of the input mechanisms from the set of **one or more** input mechanisms” in lines 3-4, which includes “**two, three, or four** of the input mechanisms from the set of **one** input mechanism”, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Further, examiner can't understand how two or more input mechanisms are from a set of ONLY one input mechanism.

6. Claims 19-21, 24-26 and 45-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Re **claim 19**, this claim recites a limitation, “a set of one or more input mechanism provided on the second segment so as to be exposed ... when in the contracted position” in last 3 lines, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Since when the device is in the contracted position, the (whole) second segment is overlaid by the first segment (see lines 10-11 of this claim) i.e., the first segment overlays the (whole) second segment, a person skilled in the art can't recognize how a set of one or more input mechanism provided on the second segment can be exposed. Accordingly, this claim contains the above underlined limitation, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Re **claims 20, 21 and 24-26**, since these claims depend upon claim 19, these claims are therefore rejected for the same reason set forth in claim 19 above.

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Re **claim 45**, this claim recites a limitation, “wherein when the second segment is in the contracted position, ..., so that the display assembly is at least partially blocked” in last 4 lines, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Since when the device is in the contracted position, the second segment is overlaid by the first segment (see lines 11-12 of this claim), i.e., the first segment including a display assembly (see line 13 of this claim) overlays the second segment, a person skilled in the art can’t recognize how the display assembly can be partially blocked and what element can partially blocks the display assembly. Accordingly, this claim contains the above underlined limitation, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Re **claims 46-50**, since these claims depend upon claim 45, these claims are therefore rejected for the same reason set forth in claim 45 above.

### ***Response to Arguments***

7. Applicant's arguments filed 04/24/2010 have been fully considered but they are not fully persuasive because as follows:

With respect to the disapproval of drawings submitted on 09/28/2009 in the Office Action dated 12/23/2009, Applicant argues that Figs. 18-19 submitted on 09/28/2009 merely mirror Figs. 1-2 (see pages 5-6 of the amendment filed 04/24/2010). Examiner disagrees because Fig. 18 and Fig. 19 do not mirror Fig. 1 and Fig. 2, respectively. Fig. 1 shows at least input mechanisms (132, 134) and items (118, 128), which are not shown in Fig. 18, and separate

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segments (110, 120) while Fig. 18 seems to show segments (110, 120) to be the same one.

Similarly, Fig. 19 does not mirror Fig. 2.

With respect to the drawing objections in the Office Action dated 12/23/2009, these objections are maintained because Figs. 18-19 are not approved by the Examiner.

With respect to the specification objection under 35 USC 132(a) in the Office Action dated 12/23/2009, this objection is maintained because Figs. 18-19 are not approved by the Examiner.

With respect to the rejections under 35 USC 112, second paragraph, to claims 48-49 in the Office Action dated 4/27/2009, these rejections are withdrawn in light of the amendment to these claims.

Applicant's arguments, with respect to the rejections under 35 USC 112, first paragraph, as failing to comply with the written description requirement to claims 19-26 and 45-50 in the Office Action dated 12/23/2009 (see pages 6-9 of the amendment), have been fully considered but they are not persuasive because the original disclosure, specifically the last paragraph on page 21 of the specification, does not provide enough information to the "claimed" mobile device of the pending claims such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, specifically the "claimed" features, "a second segment including a set of one or more input mechanisms is overlaid and external to a first segment including a display assembly when the second segment is in the contracted position" and "when the second segment is in the contracted position the second segment is overlaid and external to the first segment" of claims 19 and 45, "a set of one or more input mechanisms provided on the second segment so as to be

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exposed when the second segment is in the extended position and when in the contracted position” in last 3 lines of claim 19, and “wherein when the second segment is in the contracted position,...., so that **the display assembly is at least partially blocked**” in last 4 lines of claim 45.

With respect to the rejections under 35 USC 112, first paragraph, as failing to comply with the enablement requirement to claims 22-23 in the Office Action dated 12/23/2009, these rejections are withdrawn in light of the cancellation to these claims.

***Notice for the Withdrawal of the Art Rejections***

8. In the Office action dated 12/23/2009, Examiner erroneously indicated the reason for withdrawing the rejection under 35 USC 102(e) as being anticipated by Lipponent et al. (US 7,412,258 B1) to claims 19-21 and 24-26 and the rejection under 35 USC 103(a) as being unpatentable over Lipponent et al. in view of Kulp (US 4,803,474 B1) to claims 45-50 in the Office Action dated 04/27/2009. The distinction between the presently "claimed" invention of claims 19 and 45 is that the closest arts, Lipponent et al. and Kulp, either singularly or in combination, fails to anticipate or render obvious the limitations, “a set of one or more input mechanisms provided on the second segment so as to be exposed when the second segment is in the contracted position” (see last 3 lines of claim 19 in the amendment filed 4/24/2010) and “wherein when the second segment is in the contracted position,...., so that the display assembly is at least partially blocked” (see last 4 lines of claim 45 in the amendment filed 4/24/2010), associated with other features of these claims.

***Conclusion***

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JIMMY H. NGUYEN whose telephone number is (571)272-7675. The examiner can normally be reached on Monday - Friday, 7:00 a.m. - 3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jimmy H Nguyen/

Primary Examiner, Art Unit 2629